

REMARKS

Claims 1 – 22 are pending in the application. Claims 5 – 12, 19, 20, 21, 22 have been amended. Claims 14, 17, 18, 19 and 20 have been cancelled. New claim 23 has been added. No new matter has been added by virtue of the amendments and new claims, support being found throughout the specification and claims as originally filed.

Any cancellation of the claims should in no way be construed as acquiescence to any of the Examiner's rejections and was done solely to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Claims 1 – 4, 13, 15, 16 and 21 have been allowed. Claims 5 – 12, 19 and 20 have been objected to. Claims 14, 17, 18 and 22 have been rejected.

The Examiner notes that in view of the allowable linking claims 1 – 4, 13, 15, 16, 21, the restriction requirement as to the linked inventions is withdrawn and claims 7 – 12 have been rejoined.

Objections

The abstract of the disclosure has been objected to because it does not commence on a sheet separate from other materials of the disclosure. Applicants have made appropriate amendment to the specification to place the Abstract on a separate sheet of paper, and respectfully request that the objection be withdrawn.

The Examiner has objected to claim 5 as being of improper dependent form for failing to further limit the subject matter of a previous claim. (Office Action, p.2). The Examiner indicates that "claim 5 describes the intended use of the vector but fails to further limit the structure of the vector." (Office Action, p.2). Applicants have amended claim 5 and respectfully request that the rejection be withdrawn.

The Examiner has objected to claims 6 – 12 because “the claims recite a chimeric protein represented by a nucleic acid sequence, which sequence is the coding sequence of the protein but not an amino acid sequence.” (Office Action, p.3). Applicants have amended claims 6 – 12 and respectfully request that the rejection be withdrawn.

The Examiner has objected to claims 19 and 20 as being of improper dependent form for failing to further limit the subject matter of a previous claim. (Office Action, p.3). The Examiner indicates that the “claims are directed to a product, but not a process claim (and) the recites inactivation does not appear to further limit the structure of the vector.” (Office Action, p.3). Applicants have cancelled claims 19 and 20 and respectfully request that the rejection be withdrawn.

Claim Rejections- 35 U.S.C. § 112

Claim 22 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office Action, p.3). The Examiner argues that “claim 22 is vague and indefinite because of the claim limitation ‘site-specific.’” (Office Action, p.3). Applicants respectfully disagree.

However, without acquiescing to any validity of the Examiner's argument, Applicants have amended the claims to remove the phrase “site-specific.” Accordingly, Applicants request that the rejection be withdrawn.

Claims 14, 17, 18 and 22 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. Examiner argues that “the specification, while being enabling for treating prostate cancer in a subject for intratumoral injection of a replication conditional adenovirus vector comprising a prostate-specific TRE operably linked to a nucleotide sequence encoding an E1A/AR chimeric protein, does not reasonably provide enablement for treating prostate cancer in a subject by administering said vector from a site remote from the tumor.” (Office Action, p.4). Applicants respectfully disagree.

However, without acquiescing to any validity of the Examiner's argument, Applicants have amended claim 22 and cancelled claims 14, 17 and 18.

Applicants respectfully request that the foregoing rejections be withdrawn.

Claim Rejections- 35 U.S.C. § 103(a)

The rejection to claims 1 – 6 and 13 – 20 under 35 U.S.C. § 103(a) as being unpatentable over Rodriguez et al. (Cancer Res 1987; 57: 2559 – 63), in view of Suzuki et al. (Cancer Res 2001; 61: 1276 – 9) and Becker et al. (Mol Cell Bio 1989; 9:3878-87) has been withdrawn.

CONCLUSION

For the reasons provided, Applicant submits that all claims are allowable as written and respectfully requests early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicant's attorney/agent would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney of record.

The Director is hereby authorized to charge any credits or deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to Deposit Account No. 04-1105.

Dated: August 26, 2009

Respectfully submitted,

By 

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